

## REMARKS

### **Claim Status**

Claims 14-18 and 29 are pending and should be examined. No new matter has been added.

### **Examiner Interview**

Applicants thank Examiner Pak for helpful discussions during a telephone interview conducted on October 6, 2004.

The art of record was discussed during the interview. Specifically, Applicants explained that there would have been no motivation to combine McCoy *et al.* with Loer *et al.* Moreover, even if there were evidence of such motivation, the resultant combination would not render the presently claimed invention obvious, within the meaning of Section 103. Applicants submitted that the cited references do not teach a method for preparing an emulsion. Examiner Pak agreed to revisit the art of record, with this point in mind.

### **Priority**

The PTO alleges that "Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120." See Office Action, page 2. Applicants' Petition under 37 C.F.R. § 1.78 (a)(3) was granted on May 12, 2004. Accordingly, this rejection is moot.

### **Rejections under 35 U.S.C. § 103(a)**

Claims 14-15, 18, and 29 remain rejected under as allegedly obvious over McCoy *et al.* in view of Loer *et al.* Office Action, page 3. Applicants respectfully traverse this rejection.

For a proper combination of references, there must be some teaching or suggestion to that end in the prior art. *See, e.g.*, MPEP § 2142. Thus, the mere fact that references could be

combined or modified does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Neither McCoy nor Loer provides any suggestion that would have prompted the skilled artisan to have combined these publications in the manner posited by the examiner.

Furthermore, even if there were a suggestion that implicated such a combination, the combined teachings would not result in the claimed method. To establish a *prima facie* obviousness, all of the claim recitations must be taught or suggested by the prior art. MPEP § 2143.03.

McCoy teaches fusion proteins comprising a thioredoxin. However, as the PTO admits, “McCoy et al. does not teach a method of emulsifying the formulation comprising a fusion protein have a thioredoxin or thioredoxin reductase and an oil body.” Office Action of September 26, 2003, at page 4. Therefore, the PTO relies on Loer to remedy McCoy’s deficiencies. Yet Loer does not disclose formulating an oil body into emulsion. Accordingly, the cited combination of references does not disclose all elements of the claims and, hence, does not establish a *prima facie* case under Section 103. For at least this reason, the rejection is improper and should be withdrawn.

Claims 16-17 remain rejected over McCoy *et al.* in view of Loer *et al.* and Hildebrand *et al.* Office Action, page 4. Applicants respectfully traverse this rejection.

As discussed above, neither McCoy nor Loer teaches all of the elements of the claimed invention. The PTO reliance on Hildebrand, to remedy the deficiencies of McCoy and Loer, is misplaced, however. According to the PTO, Hildebrand discloses a method of expressing heterologous proteins in safflower cells, but does not disclose a method for emulsifying an oil body. Office Action, page 4. Accordingly, the cited references would not render the present invention obvious and the rejection should be withdrawn.

**CONCLUSION**

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered, placing the claims in condition for allowance. Applicants' remarks neither raise new issues nor necessitate the undertaking of any additional search of the art by the examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the examiner.

Finally, applicants submit that the entry of the amendment would place the application in better form for appeal.

If there are any questions concerning this application, the examiner is courteously invited to contact the undersigned counsel.

Respectfully submitted,

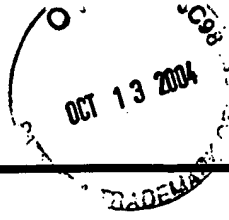
Date October 13, 2004

By  \_\_\_\_\_

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**09/897,898 Thioresdoxin and thioresdoxin reductase containing oil body bas**

Application Data	Transaction History	Image File Wrapper	Continuity Data	Published Documents	Publication Dates
Date	Contents Description				
10-07-2004	Examiner Interview Summary Record (PTOL - 413)				
05-13-2004	Mail Final Rejection (PTOL - 326)				
05-12-2004	Petition Decision - Granted				
03-18-2004	Final Rejection				
02-06-2004	Petition Entered				
01-08-2004	IFW Amended case processing Complete				
01-08-2004	Date Forwarded to Examiner				
12-24-2003	Response after Non-Final Action				
09-26-2003	Mail Non-Final Rejection				
09-25-2003	Non-Final Rejection				
07-24-2003	Date Forwarded to Examiner				
07-11-2003	Response after Non-Final Action				
07-11-2003	Request for Extension of Time - Granted				
01-14-2003	Mail Non-Final Rejection				
01-13-2003	Non-Final Rejection				
11-07-2002	Case Docketed to Examiner in GAU				
10-30-2002	Date Forwarded to Examiner				
10-15-2002	Response to Election / Restriction Filed				
09-16-2002	Mail Restriction Requirement				
09-16-2002	Requirement for Restriction / Election				
04-19-2002	Information Disclosure Statement (IDS) Filed				
11-24-2001	Case Docketed to Examiner in GAU				
10-30-2001	Application Dispatched from OIPE				

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